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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/662,176	
	Filing Date	September 14, 2000	
	First Named Inventor	Toshiyuki YAMASHITA	
	Art Unit	3627	
	Examiner Name	M. A. Cuff	
Total Number of Pages in This Submission	6	Attorney Docket Number	325772019400

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	MORRISON & FOEBSTER LLP		
Signature			
Printed name	Barry E. Bretschneider		
Date	March 26, 2007	Reg. No.	28,055



PATENT
Docket No. 325772019400

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In the application of:

Toshiyuki YAMASHITA et al.

Serial No. 09/662,176

Filing Date: September 14, 2000

For: PARTS-MANAGEMENT SYSTEM, METHOD
OF MANAGING PARTS AND PARTS-
MANAGEMENT APPARATUS

Examiner: Michael A. Cuff

Art Unit: 3627

APPELLANTS' REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief responds to the Examiner's Answer mailed January 26, 2007.

The Examiner's Answer presents what is in effect a new ground of rejection.

Accordingly, this reply brief is appropriate to respond to the new ground of rejection raised by the Examiner and to issues where the Examiner's Answer misapprehended appellant's Opening Brief.

- A. The Examiner has relied on a new ground of rejection by adding improperly taken "Official Notice" that transmitters can be used in place of network connections.**

In addition to relying on the Okigami and Antziopoulos references used in the final Action as evidence of obviousness, the Examiner now invokes "'Official Notice' that multiple transmitters can take the place of network connections in order to provide a cheaper and more

simple [sic] means of data transfer” to buttress the rejection. See page 4 of Examiner’s Answer. By doing this, the Examiner has altered the evidentiary support for, and thrust of, his argument in support of the rejection without following the procedures required for what is in truth a new ground of rejection. See MPEP 1207.03. See also *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). That the Examiner would have to take “Official Notice” at this late stage of prosecution demonstrates that upon reading appellants’ brief the Examiner decided that he erred in asserting Okigami in view of Antziopoulos as the sole basis for rejection.

Invoking Official Notice is only appropriate in rare instances, where the facts asserted without citation to evidence of record are well-known or common knowledge capable of instant and unquestionable demonstration as being well-known. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). See also MPEP 2144.03(E). This is not one of those rare instances. The Examiner has simply ignored the standards for invoking Official Notice. General conclusions of what the Examiner personally considers “basic knowledge” to one of ordinary skill in the art absent specific factual findings and some concrete evidence are of no consequence and will not support an obviousness rejection. Cf., 37 CFR 1.104(d)(2). By raising Official Notice for the first time on appeal, the Examiner has deprived appellants their right under 37 CFR 1.104(d)(2) to require the Examiner to substantiate his taking of Official Notice. What the Examiner knows but cannot substantiate is irrelevant to appellants’ claims.

Even more tellingly, the Examiner now relies on Official Notice as his principal evidence in rejecting the claims. See *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). If Official Notice serves as the principal evidence in support of the rejection, then the reliance on Official Notice undoubtedly alters the thrust of the Examiner’s argument presented.

Accordingly, because the Examiner has interposed a new ground of rejection in his Answer without following the proper procedure for doing so as required under MPEP 1207.03, appellants respectfully request that the Board reverse the rejection of claims 1-4 and 6-17.

B. FIGS. 1 and 2 of Okigami do not correspond to the claimed management apparatus.

The Examiner's claim chart equates appellants' management apparatus with elements of FIG. 1 and FIG. 2 of Okigami. See page 5 of Examiner's Answer. The trouble management server in Okigami only gauges the operational value of the part within a specific image-forming machine.

Reading claims in light of the specification to as to give them their proper broadest reasonable interpretation is nothing new or controversial in patent law. The Examiner's refusal to apply this bedrock precept, by interpreting the claims without regard to the specification of this application, his position is wrong. See *In re Marosi*, 710 F.2d 799,218 USPQ 289 (Fed. Cir. 1983) ("Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation.'") The Patent and Trademark Office determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art" *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Appellants' specification discloses that the operating lifespan of each copier part can be continuously managed **even when** the part has been moved from copier to copier, for example. The usable lifespan of a part is not directly related to the lifespan of the copier itself, so it is not reasonable for the Examiner to construe the claims otherwise. Appellants emphasize that an advantage of their invention is that "each part can be used as long as possible." See page 4, lines 13-20, of the specification. Appellants frame the issue that the claimed invention addresses as follows: optimizing the use of a copier part, for example, by tracking the part's usage over multiple installations in more than one copier machine. Tracking total part usage as claimed distinguishes the claimed invention from the prior art. Okigami, in contrast, only refers to the operational value of a part within a specific image creating machine and not its overall usage. The cited prior art restricts its monitoring to one installation of a part in one device, and not

monitoring the part in however many machines it might be installed in, thus distinguishing appellants' invention from the prior art.

C. The Examiner's contention that he has established obviousness by singling out the advantage created by the claim language is not proper since it fails to consider the subject matter of the invention as a whole.

Obviousness requires that a teaching or suggestion of every element of the claimed invention be present in some combination of the prior art cited. Contending that "transmitters can take the place of network connections in order to provide a cheaper and more simple means of data transfer," as the Examiner does, contradicts the MPEP. See page 4 of Examiner's Answer. The MPEP warns patent examiners against distilling an invention under examination down to an advantage that it provides. Doing so is an improper basis for an obviousness rejection. See MPEP 2141.02. See also *Jones v. Hardy*, 727 F.2d 1524, 1530, 220 USPQ 1021, 1026 (Fed. Cir. 1984) ("treating the advantage as the invention disregards statutory requirement that the invention be viewed 'as a whole'").

Furthermore, the Examiner's proposition is unsupported, since the alleged motivation, making a device or process cheaper or simpler, is so general as to amount to no motivation at all. The motivation for a person of ordinary skill in the art to make a claimed invention must be grounded in either the cited references or the level of ordinary skill in the art, which the cited references evidence. See *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). Some evidence of the alleged motivation that the Examiner relies upon must exist; simple supposition of a motivation does not suffice. See *In re Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002). There is no permissible motivation substantiated by evidence of record to modify Okigami and combine it with Antziopoulos. Even if there were, the combination would not achieve the claimed invention.

Appellants also note the Examiner's excessive rewriting and reordering of the claims as a basis for rejection. Dismantling the claim language is wrong and results in dissecting the invention instead of evaluating the patentability of the claimed subject matter as a whole as

required by 35 USC 103(a). Contrary to the Examiner's interpretation of proper examining procedure, once the Examiner determines the differences between the prior art and the claims, the Examiner must consider whether the claimed invention as a **whole** would have been obvious at the time the invention was made, not whether the differences would have been obvious. See *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Circ. 1983). The claim chart rearranges the claim in such a way that it does a disservice to the Board's understanding of the claims. It is thus not proper in examination to dismantle a claim for the purpose of rejecting it as the Examiner has done. Accordingly, applicants request that the Board reverse the rejection under 35 USC 103(a).

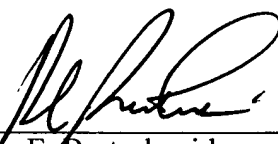
CONCLUSION

For the foregoing reasons, appellants respectfully request that the Board reverse the final rejection of claims 1-4 and 6-17.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, appellants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. **325772019400**.

Dated: March 26, 2007

Respectfully submitted,

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